REMARKS

I. Status of the Claims

Claims 1-27 are pending in this application. Applicant thanks the Examiner for the indication of allowable subject matter in claims 11 and 12. No claims have been cancelled or amended by this response

Applicant petitions the Examiner to formally withdraw the designation of the present Office Action as "Final." As indicated in the Office Action on page 2, the Examiner has introduced a new ground of rejection, and therefore the designation of "Final" in inappropriate. The Examiner acknowledged this error in a telephone conference with Thalia Warnement, counsel for Applicant, on April 22, 2003. Applicant requests that the Examiner send to Applicant's undersigned representative an interview summary indicating the mistake. Nevertheless, Applicant has filed an RCE to ensure that the documents submitted in the Supplemental Information Disclosure Statement are considered.

II. Supplemental Information Disclosure Statement

Applicant submits herewith a Supplemental Information Disclosure Statement and PTO 1449. The art introduced into the record was cited in an opposition to the patent that is the European equivalent of the instant application.

III. Rejection Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-10 and 13-27 under 35 U.S.C. §103(a) as being unpatentable over Kanji Narazaki et al. (JP 03220114) ("Narazaki") in view of Yoshihara et al. (U.S. Pat. No. 5,102,655) ("Yoshihara"). Specifically, the Examiner alleges that Narazaki "teaches removable hair dye compositions that use a pigment as

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

the coloring agent and which fall within the scope of the claimed cross-linked polymers...." Office Action at 2. The Examiner admits that the present claims differ from Narazaki by reciting direct dye components, and relies on Yoshihara to cure the deficiency. The Examiner alleges that Yoshihara "teaches a composition comprising hair dyeing base components such as acid dyes, pigments such as carbon black and other coloring agents such as acridine dye, azine dye, quinoline dye and anthraquinone dyes...." Office Action at 3. The Examiner concludes, "it would have been obvious...to modify the primary reference by substituting the carbon black pigment as a coloring agent with the acidic dyes, azo dyes or anthraquinone dyes taught by Yoshihara...." *Id.* According to the Examiner, the modification would have been obvious "because Yoshihara teaches the equivalence between the dyes such as acid dyes, azo dyes, or anthraquinone dyes and the pigments such as carbon black and thus clearly suggests that these can be used in alternative." *Id.* Applicant respectfully traverses this rejection.

To establish a prima facie case of obviousness, the Examiner must meet three basic criteria. First, the Examiner must show that there is some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one skilled in the art, to modify a reference or combine reference teachings. Second, the Examiner must demonstrate there is a reasonable expectation of success in making this modification or combination. Finally, the prior art references must also teach or suggest all the claim limitations. See M.P.E.P § 2143. Furthermore, the teaching or suggestion to make the claimed combination must be found in the prior art,

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In this case, Applicant believes that the Examiner has failed to meet all of the above criteria.

No Motivation to Combine the Reference Teachings

While Yoshihara does teach coloring agents such as azo dye and anthraquinone dye (see Col. 4, lines 44-48), as is claimed in the present invention, the Examiner has not shown any motivation to combine these coloring agents with at least one crosslinked polymer containing acrylic residue units as is presently claimed. Contrary to the position taken by the Examiner, Narazaki extols the virtues of a polysiloxane-group-containing anionic resin, and actually teaches away from the use of singular acrylic residue units.

In particular, Narazaki states that commonly used resins, such as acrylic acid, or resins containing methacrylates with alkylesters of acrylic acid and methacrylic acid "do not have sufficient wear resistance; as a consequence, when they are rubbed hard...the pigments are transferred to them, thereby soiling clothes, cloth, etc." Narazaki at p.5 (English translation). Narazaki then goes on to say that polysiloxane-group-containing anionic resins do not have this wear resistance problem. *Id.* at 5-6. Even though the polysiloxane-group-containing anionic resin is obtained by copolymerizing monomer derived from, *e.g.* (meth)acrylic acid, Narazaki does not teach that the monomer units are viable. See Narazaki page 6. Instead, Narazaki teaches that only after the units are copolymerized are they useful. *Id.* Based on these facts, one skilled in the art

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

would not have been motivated to substitute the polymers of Yoshihara for the resins of Narazaki.

Moreover, Yoshihara suggests the optional use of anionic polymers as dyeing agents, and describes four families of anionic polymers that can be used. See col. 6, lines 40-58. The polymer used in the present invention, however, is distinguishable from the listed polymers in Yoshihara because it includes an alkyl acrylic ester while the polymers in Yoshihara do not. Thus, even if the combination were made, and Applicant again submits that no motivation exists to do so, it would not read on the claims of the instant application (see *infra.*)

No Reasonable Expectation of Success

Narakazi does not contemplate the use of an azo dye or anthraquinone dye in combination with its resin, let alone an acidic or cationic dye or anything other than a pigment as disclosed on page 17 of the English translation. Yoshihara does not remedy this deficient teaching because these compositions require the use of a branched-type quaternary ammonium salt and a mixture of linear and branched higher alcohols *optionally* in combination with a dyeing agent. It is not clear why would one of ordinary skill would reasonably expect success in taking the optional dyeing agent out of Yoshihara's composition and placing it into Narazaki's composition, which contemplates pigments only.

The distinction between the pigments in Narazaki and the direct dyes in Yoshihara is important. When a pigment is applied to hair, it is localized only on the surface of the hair, without penetrating into the hair. On the other hand, a direct dye is

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

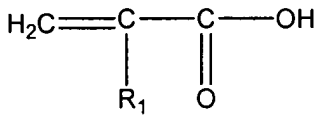
1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

partially localized within the hair fibers. This difference is important because it suggests that Narazaki and Yoshihara achieve their purpose via different mechanisms. One skilled in the art would not reasonably expect success from the combination of elements derived from inventions that act through disparate processes.

The Examiner is essentially picking and choosing individual components from the prior art, without regard to the context from which these components came. The components work in concert to produce a desired effect, and the Examiner has failed to provide any evidence to show why one of ordinary skill in the art would have reasonably expected a successful dye to be formed from the proposed modification resulting from picking and choosing elements from the prior art. The Examiner must specifically point to evidence that suggests that there would have been a reasonable expectation of success if the elements from the references were combined as he proposes.

No Teaching of All the Claim Elements

Further, when taken together, the references do not teach all the claimed limitations. Specifically, the claimed at least one crosslinked polymer contains acrylic residue units, which the Examiner has not shown to be disclosed by Narazaki. The presently claimed invention has acrylic units of structure

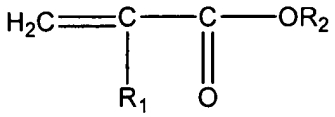


where R_1 can be H, CH_3, C_2H_5, and C_{10}-C_{30} alkyl acrylate residue units.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

In contrast, Narazaki's general structure is



where R_1 is a hydrogen atom or a methyl group and R_2 is an alkyl group having 1 to 24 carbon atoms or an alkenyl group. Thus, because R_2 cannot be H (the smallest group is a methyl group), Narazaki does not teach or suggest all of the claimed elements.

IV. Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 13, 2003

By: 
Mark D. Sweet
Reg. No. 41,469

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com